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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,184	11/03/2003	Stephen Patrickneal Scarpone	6012-1255	3972
22446	7590	03/21/2006	EXAMINER	
ICE MILLER LLP ONE AMERICAN SQUARE, SUITE 3100 INDIANAPOLIS, IN 46282-0200				BERNATZ, KEVIN M
ART UNIT		PAPER NUMBER		
1773				

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/700,184	SCARPONE, STEPHEN PATRICKNEAL	
	Examiner	Art Unit	
	Kevin M. Bernatz	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
 - 4a) Of the above claim(s) 20-40 is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/9/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claims 1, 2, 4, 5, 9 and 12 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (U.S. Patent No. 6,220,305 B1) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on October 7, 2005.

Claim Rejections - 35 USC § 103

3. Claims 1 – 7 and 9 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. as applied above, and further in view of Boyer et al. (U.S. Patent No. 6,403,659 B1) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on October 7, 2005.

4. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. as applied above in Paragraph 2, and further in view of the IDS article by Mirtchi et al. ("Polycyclic aromatic hydrocarbons (PAH's) in pitches used in the aluminum industry") for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on October 7, 2005.

5. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Boyer et al. as applied above in Paragraph 3, and further in view of the IDS article by Mirtchi et al. ("Polycyclic aromatic hydrocarbons (PAH's) in pitches used in the aluminum industry") for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on October 7, 2005.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Boyer et al. as applied above in Paragraph 4, and further in view of Pennie (U.S. Patent No. 3,607,515) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on October 7, 2005.

Response to Arguments

7. The rejection of claims 1 - 19 under 35 U.S.C § 102(b) and/or 103(a) – Johnson et al., alone or in view of various references

Applicant(s) argue(s) that Johnson et al. does not disclose a "petroleum base", "that the "coal tar oil" as disclosed in Johnson et al. is different from the "petroleum base" claimed in Applicants' claims 1 and 9", that there are two separate families of materials that are being discussed "coal tar" and "petroleum" (pages 11 – 12 of response) and that "nothing in Johnston et al. discusses or suggests an enamel formulation comprising ingredients of the coal "family" and a petroleum or petroleum-based ingredient" (page 19 of response) . Applicants also point to cited prior art (IDS

reference from *Introduction to Carbon Technologies*) as an attempt to distinguish coal tar pitch/oil from petroleum pitch/oil (pages 12 – 13), as well as noting that Boyer et al. explicitly teach “coal tar pitch” and “petroleum pitch” (page 16 of response). The Examiner respectfully disagrees.

The Examiner notes that applicants’ arguments are essentially directed to nomenclature and to the scope given the terms “coal tar” and “petroleum” as they modify “pitch” and “oil”. It is the Examiners position that applicants are mischaracterizing the families which are pertinent to evaluating the prior art – the families of “coal tar” and “petroleum” are merely process-related adjectives to describe how the “pitch” or “oil” is formed (or where it is derived from). Even the cited IDS reference acknowledges this by stating “[b]oth coal-tar pitch and petroleum pitch are complex mixtures of numerous organic compounds predominantly polycyclic aromatic hydrocarbons” (*First paragraph of Introduction*). While there are certainly some minor differences between a “coal tar” formed pitch and a “petroleum” formed pitch, the Examiner notes that no two “coal tar” pitches are identical, nor any two “petroleum” pitches. The exact chemical make-up of almost any petroleum or coal-based product depends strongly on the feed material and each batch of feed will possess some variance even to other batches from the same source. The Examiner notes that the Boyer et al. also appears to support the Examiner’s position that the critical product limitations are *pitch* and *oil*, not *coal-tar* and *petroleum*.

As such the Examiner maintains that the critical *product* limitation is “pitch” and “oil”, not “coal tar” and “petroleum” as argued by applicants. The “coal tar oil” of

Johnson et al. is deemed to be a hydrocarbon oil, exactly like the claimed “petroleum oil” (see Webster’s dictionary definitions of Coal-tar oil and Oil – Petroleum). Whether the hydrocarbon oil is formed from coal-tar sources or petroleum sources does not change that the actual product is, in the broadest reasonable interpretation consistent with the written description in applicants’ specification as it would be interpreted by one of ordinary skill in the art, a hydrocarbon oil. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994).

Applicants further argue that Boyer et al. is non-analogous to the present invention, and hence combination with Johnson et al. is improper since Boyer et al. is only directed to “an asphalt based driveway sealer” (*pages 16 and 17 of response*). The Examiner respectfully disagrees and notes that that Boyer et al. is directly analogous to Johnson et al. since both are directed to pipe coatings (see *Boyer et al.*, col. 10, lines 56 – 59).

Regarding applicants’ argument that “nothing in Johnson et al. supports the use of a cut-back oil as disclosed in Boyer et al.” (*page 17 of response*), applicant(s) are reminded that “the test for obviousness is not whether features of the secondary reference may be bodily incorporated into the primary reference’s structure, nor whether the claimed invention is expressly suggested in any one or all of the references, rather the test is what the combined teachings would have suggested to those of ordinary skill in the art.” *Ex parte Martin* 215 USPQ 543, 544 (PO BdPatApp 1981). In the instant

case, Boyer et al. teach the benefits of using the claimed cut-back oil as noted in the rejection of record.

Regarding applicants' argument that "the cut-back oil of Boyer et al. is used as a dilutant, while the petroleum base of the present Application is a specific reagent of the enamel formulation", an invention may be obvious if the prior art has different reasons for doing what the applicant has done. "It has long been held that a rejection under 35 USC 103 based upon a combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention." *Ex parte Raychem Corp.* 17 USPQ 2d 1417, 1424 (BPAI 1990). Cites *In re Kronig* 190 USPQ 425 (CCPA 1976); *In re Gershon* 152 USPQ 602 (CCPA 1967).

In response to applicants' argument that "nothing in Boyer et al. discusses or suggests that its sealer formulation with the cut-back oil provides any advantages over the other enamel formulations known in the prior art" (*page 19 of response*), the Examiner notes that Boyer et al. teach reduced toxicity, which is deemed to be a "advantage over the other enamel formulations".

Regarding applicants' argument that Boyer et al. teach away from coal tar pitch (*pages 19 – 20 of response*), the Examiner notes that Boyer et al. teach *minimizing* the amount of coal-tar pitch used by replacing some, not necessarily all, with petroleum pitch (*col. 3, lines 34 – 56*). At no point does Boyer et al. require that no coal-tar pitch be used at all, but merely teaches the benefits of using a less toxic petroleum-based pitch to reduce the amount of coal-tar pitch used in the final product. The Examiner

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also notes that Boyer et al. explicitly teach that the two materials are essentially interchangeable and the mixture of the two is based on obtaining optimal properties where one type of pitch might be better than the other (e.g. in weathering resistance or perhaps impact resistance).

Finally, applicants argue that there is a difference between the claimed "enamel" and a "sealer" as disclosed by Boyer et al. (*pages 20 – 24 of response*), hence making Boyer et al. non-analogous art. The Examiner respectfully disagrees.

Applicants again appear to be arguing nomenclature. First, the Examiner notes that a claim limitation must be given the broadest reasonable interpretation(s) consistent with the written description in applicants' specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). "Enamel" is not defined in the specification and the broadest reasonable interpretation is a liquid or semi-liquid coating. "Sealer" has the same exact broadest reasonable interpretation and the Examiner does not find applicants' arguments convincing that the nomenclature "enamel" conveys patentable distinction versus a composition termed a "sealer" (the Examiner cannot help but ask, does not an "enamel" seal?).

Furthermore, Boyer et al. is not even required to *teach* the limitation enamel since that limitation is taught by Johnson et al. (as admitted to by applicants through-out this response). The fact that Boyer et al. explicitly states that their composition is useful for pipe coatings means that their disclosure is analogous to Johnson et al. and

Johnson et al. is relied upon for the limitation “enamel”, even though the Examiner maintains that there is no structural difference between the terms “enamel” and “sealer”.

In summary, the Examiner notes that applicants appear to be focusing on nomenclature, arguing that modifying words like “coal-tar”, “petroleum” and “enamel” convey structural limitations into the claims. If these terms were specifically defined in applicants’ as-filed disclosure, then the Examiner would entertain the “reading into” the claims of the argued structural differences. However, these terms are not clearly defined by the as-filed disclosure, so they must be given the broadest reasonable interpretations, interpretations that preclude “reading into” the claims the narrow structural limitations argued by applicants. If applicants maintain the desire to distinguish the claimed invention by the alleged structural difference in the argued terms, the Examiner recommends amending the claims to positively incorporate said structural features. I.e. those structural features that applicants feel distinguish a “coal tar” formed product from a “petroleum” product and/or an “enamel” form a “sealer”. Of course, applicants are reminded to insure that no new matter is introduced.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

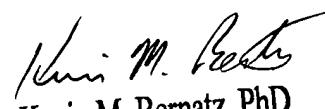
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
March 1, 2006


Kevin M. Bernatz, PhD
Primary Examiner